

REMARKS

The Office Action objected to claim 12 and rejected claims 11-12 under Section 112. Claims 1-6, 8-12 and 14-20 were rejected under Section 102e as anticipated by Meridian Project Systems, Inc. (Meridian). Further, claims 7 and 13 were rejected
5 under Section 103a as unpatentable over Meridian.

The Section 112 Objection/Rejection

Claims 11-12 have been amended. Withdrawal of the Office Action is respectfully requested.

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The Section 102 Rejection

Claims 1-6, 8-12 and 14-20 were rejected under Section 102e as anticipated by Meridian. Applicants respectfully traverse the comparison of Meridian to the claims. Meridian's suite of products includes Prolog Pocket which "allows users to collect data
15 such as inspections and tests, material deliveries, safety notices, punch lists, notices to comply and events. Once the data is entered into Prolog Pocket, it can be uploaded to Prolog Manager 5 for additional reporting capabilities. Data can also be downloaded from the latest Prolog Manager database to Prolog Pocket for quick, accurate, and up-to-date information for mobile users." Prolog Manager 5 in turn provides "Purchasing, Cost
20 Control, Engineering and Superintending features. The brand new Purchasing Module manages the entire procurement process. You can track Buyout Items, Bid Packages, Bid Analysis, Contract Attachments, and a master Vendor database."

Turning to the claims in the instant case, the independent claims recite a handheld computer adapted to collect construction data from the field; a planning system to track budgetary information; a design system to perform site engineering assessment; and a construction system to track material consumption and progress for each project, the
5 construction system adapted to receive data collected from the handheld computer.

The Office Action asserted that Meridian shows a "planning system to track budgetary information (See at least page 1, sections 1-2, page 2, section 1, page 3, section 3, page 13, sections 1-3, pages 14-16, page 17, sections 1-3, page 19, and page 28, sections 1-3, wherein planning system features are disclosed that track the budget
10 information)." However, this part of Meridian is essentially an accounting system. The Meridian system cannot track funding sources, the allocation of the funding sources, and scheduling information. Meridian also cannot maintain data relating to preliminary site feasibility studies such as estimates of the cost of the project. Hence, at least the planning system is missing in Meridian and this is one basis to traverse the rejection.

15 In the instant invention, the specification discloses an embodiment of the planning system 102 as a budgetary system that tracks funding sources, the allocation of the funding sources, and scheduling information. As noted on pages 16-17 of the application, in one embodiment, "the planning system 102 includes a Fund/Source Module that maintains multi-year budget plans for the overall CIP process. This allows
20 program managers to create a multi-year Capital Improvement Plans and track the funding sources by program, fund, and by source. Each CIP plan is controlled separately to maintain a historical record of the previous year's CIP plan. This Planning System controls and manages the data associated with this process." Meridian does not manage

the multi-year capital improvement budget process for program management that requires a system to adjust projects based on priorities, condition assessments, and maintenance considerations. Since the planning system is not taught by Meridian, this is one basis for traversing the Section 102 rejection.

5 The claims also recite a design system. As disclosed in the specification, in one embodiment, the design system 104 allows the user to perform detailed site assessments. The user can check for a variety of concerns, for example environmental concerns. The design system 104 also allows the user to start a preliminary design that meets predefined requirements on a particular project. The design system 104 also performs contract
10 management aspects of the design contract, including tracking whether a design engineering company or an architectural firm has delivered certain items. The design system 104 also performs contract management and archives any court document control such as correspondence between an owner and a design firm.

 The Office Action asserted that Meridian shows a "design system to perform site
15 engineering assessment (See at least page 1, sections 1-4, page 2, section 1, page 3, sections 1-5, page 13, sections 1 and 3, page 15, and page 28, sections 1-3, which includes a system for engineers and engineering site analysis)." Applicants have carefully reviewed the pages, and failed to find the design system. Although page 15 of Meridian mentions the word "Engineering", but the Meridian Engineering functionality is
20 limited to document management for engineering diagrams and not a design system to perform site engineering assessment. To illustrate, page 15 is replete with logs, records of conversations, drawing history/list/packages, and submittal packages and transmittal cover sheet. However, there is no design functionality in Meridian.

In the instant application, one embodiment of the design functionality is described as follows:

The Design System manages the document control process for design process. This system contains various modules that provide the PCS functions from Design Contract Award to Construction Contract Award. The following are the modules and the sections below will describe how each Design System module controls the design information by performing documentation control of design information for each individual their projects:

- Design Contract Award Phase Module
- Design Phase I Module
- Design Phase II Module
- Design Review Module
- Post Advertisement to Bid Phase Module
- Post Bid to Construction Contract Award Module

Meridian is completely silent on the design system. Hence, at least the design system element is missing from Meridian. This is another independent basis for traversing the rejection.

The Office Action also asserted that Meridian shows a "construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer (See at least page 1, sections 1-2, page 2, section 1, page 3, sections 1-5, page 4, page 13, sections 1-3, pages 14-16, page 17, sections 1-3, page 19, and page 28, sections 1-3, which discloses a

construction system to track progress and material consumption to generate reports using information from the handheld computer)."

As disclosed in the specification, one embodiment of the construction system 106 tracks the actual materials consumed and the progress of the project. For example, data relating to construction items previously bid upon can be reviewed in determining the quantity of material delivered and the payment to a particular contractor for its construction items. The system 106 can track on a daily basis the quantities of the materials being delivered to the job site, the progress of the work and the resulting pay estimate sheets. The construction system 106 also performs various contract management functions, including archiving all contract documents and correspondence associated with a particular construction management construction firm.

MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Here, since the prior art reference relied upon by the examiner in a § 102 rejection does not contain every element recited in the claim in as complete detail as is contained

in the claim and arranged as recited in the claim, Applicants respectfully traverse the rejection as being improper.

Moreover, since Meridian cannot anticipate claims 1 and 14, Meridian cannot anticipate the claims that depend therefrom. Withdrawal of the Section 102 rejection is
5 requested.


The Section 103 Rejection

Claims 7 and 13 were rejected under Section 103a as unpatentable over Meridian. Applicants respectfully traverse the rejection since claims 7 and 13 depend from
10 allowable claim 1. Moreover, since Meridian fails to show at least the design system to perform site engineering assessment, Meridian cannot render claims 1, 7 and 13 obvious. Withdrawal of the §103 rejection is respectfully requested.

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of
15 Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-528-1490.

Respectfully submitted,


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